

REMARKS

In the Office Action of April 27, 2005, the Examiner objected to claim 13 because of the following informality: In claim 13, line 6 the phrase "cutting the engraved the metal" should be changed to "cutting the engraved metal". By way of this Amendment, Claim 13 has been amended to correct the informality. Thus, claim 13, as amended, is believed to be in condition for allowance.

Claim 1 stands rejected under 35 USC 102(e), as being anticipated by Williams (U.S. 6,493,972). As the Examiner is well aware, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Company of California*, 2 U.S.P.Q. 2d. 1051, 1053 (Fed. Cir. 1987), *cited in*, M.P.E.P. §2131. "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989). In addition, the elements must be arranged as required by claim. M.P.E.P. § 2131, *citing*, *In Re Bond*, 15 U.S.P.Q. 2d. 1566 (Fed. Cir. 1990). Thus, if any feature taught by the claimed invention is not taught by the reference cited by the Examiner, then the claimed invention and the reference are patentably distinct. In such a case, a rejection under 35 U.S.C. § 102 is improper.

In the case *sub judice*, Williams does not anticipate the present invention. Indeed, the Examiner has incorrectly stated that Williams discloses "the remainder of the first side outside the pre-selected lens portions (see fig. 1 ref. 42, 44, 46, 48, 50, 52 and 54) is unaltered." In fact, Williams teaches that the tab portions are altered by the application of an adhesive such as glue! *See*, Col. 2, l. 65 – Col. 3 l. 1. The application of the adhesive material is such that the tabs can be fastened together thereby forming a cube. Further, unlike the present invention, Williams discloses a **product cube** having lenticular lens extending across the entirety of the sheet (every frame) in the same direction. The present invention may comprise any package design and discloses that the lens

patterns may be placed in pre-selected areas only, as opposed to running the entire length of the sheet. The location of the lens pattern may be anywhere along the sheet and may include only one frame or even a portion of a single frame, as it relates to cube type structures. As such, Williams does not anticipate the present invention as it does not teach every element. Accordingly, Applicant requests that the rejection be withdrawn.

Claims 1, 2, 6, 8 and 14 stand rejected under 35 U.S.C. 103(a), as being unpatentable over by Young *et al.* (U.S. 5,699,190) in view of Williams. Generally speaking, "to establish a *prima facie* obviousness of the claimed invention, all the cited limitations must be taught or suggested by the prior art." *In Re Royka*, 490 Fed. 2d. 981 (C.C.P.A., 1974). "A statement that modifications to the prior art to meet the claimed invention would have been well within the ordinary skill of the art at the time the claimed invention was made because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references." M.P.E.P. § 2143.02, citing, *Ex parte Levengood*, 28 U.S.P.Q. 2d. 1300 (Bd. Pat. App. 1993).

Moreover, one cannot pick and choose among the individual elements of assorted prior art references to recreate the claimed invention. The combination of claims are not to be invalidated based merely upon a finding of similar elements in separate prior art references. *See generally, Smith Kline Diagnostics, Inc. v. Helena Laboratories, Corp.*, 859 Fed. 2d. 878, (Fed. Cir. 1988). The mere fact that references can be combined or modified does not render the resultant combination unless the prior art also suggests the desired validity of the combination. M.P.E.P. § 2143.01; *In re Mills*, 1916 Fed. 2d. 680, (Fed. Cir. 1990). There must be some objective support.

Presently, the Examiner has incorrectly determined that Young *et al.* discloses all of the elements of the claimed invention except for the step of forming a pre-determined design from the substrate. Thus, the 103(a) rejections are improper. Indeed, Young *et al.* teaches of:

A lenticular media comprising at least one encoded portion adjoining a main portion, wherein said encoded portion is positioned to provide alignment and registration for precisely determining the location of the main portion, said encoded portion comprising a plurality of planar regions, each of said planar regions being separated by at least one lenticule.

See generally, Young *et al.* Claim 1 (emphasis added).

In regard to the plurality of planar regions taught by Young *et al.*, they are simply a directional guide or a manner of alignment and registration. There is no desired optical effect produced by the use of the planar regions in conjunction with the lenticules. Further, each planar region, as disclosed in Young *et al.*, is of a size substantially similar to the lenticules produced, or increments thereof. See, Col. 3, l. 55-65. Finally, and most glaringly, the planar regions of Young *et al.* are unidirectional, continuous along the entire length of the lenticular media produced and **must** be separated by at least one lenticule.

In contrast, the present invention, as presently claimed in independent claims 1 and 14, is comprised of a lenticular sheet having at least one lens pattern located on a first side of a substrate. Unlike Young *et al.*, there may be more than one lens pattern on the substrate which may produce various, distinct desired optical effects. Further, contrary to Young *et al.* the lens pattern of the present invention may be of any shape and/or size and may be located in any space upon the substrate. Likewise, the unaltered remaining portions of the substrate of the present invention, or planar regions, may be of any shape and/or size and located on any space of the substrate, as long as they do not overlap the lens pattern. This is in contravention to the teachings of Young *et al.* since the planar regions of Young *et al.* are required to (1) run the entire length of the lenticular media; (2) have a size similar to the lenticules produced, or increments of the lenticules produced; (3) be continuous and unidirectional; and (4) must be present. Thus, Young *et al.* appears to teach away

from the present invention by restricting the size, direction, and scope of the planar regions.

Notwithstanding the above and by way of this Amendment, Applicant has amended independent claims 1 and 14 to clarify the aforementioned features. As such, the rejections by the Examiner are believed to be overcome and withdrawal of the same is respectfully requested.

With respect to claims 2, 6 and 8, these claims are dependent from independent claim 1. As Young *et al.* in view of Williams fails to teach the elements of independent claim 1, they cannot be used as a basis for rejecting the dependent claims. Thus, Applicant requests that these rejections be withdrawn. Further, the Examiner has objected to claims 4, 5 and 9-12 as being dependent upon a rejected base claim. In view of the foregoing amendments and remarks, these claims are now believed to be in condition for allowance.

Claims 3 and 7 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Young *et al.* in view of Goggins and Young *et al.* in view of Karszes, respectively. With respect to these claims, the Examiner has premised the rejections upon the arguments relating to Young *et al.* and independent claim 1.

It is submitted that the rejections of claims 3 and 7 under 35 U.S.C. § 103(a) are improper and, therefore, Applicant requests withdrawal of the same. As set forth in detail above, Applicant has amended independent claim 1. Thus, the rejections pertaining to the use of Young *et al.* in view of Goggins and Young *et al.* in view of Karszes, respectively, to reach the elements of claims 3 and 7 are now moot. As such the rejections should be withdrawn.

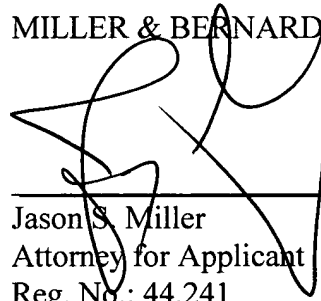
Finally, Applicant has added new claims 15 and 16. Neither of these claims add new matter, nor are they in excess of the allowable number of claims for the fees previously paid. Thus, no new fee is believed necessary and the claims are believed proper. All claims, as filed, currently amended and new, are believed to be in condition for allowance.

The remaining references which were cited but not applied have been thoroughly reviewed, but clearly are no more pertinent to the claims than the references relied upon in the rejections.

In view of the foregoing amendments and remarks, this application is now believed to be in condition for allowance and such favorable action is respectfully requested on behalf of Applicant.

Respectfully submitted,

MILLER & BERNARD, PLLC

A large, stylized handwritten signature in black ink, appearing to read 'J. S. Miller', is written over a horizontal line.

Jason S. Miller
Attorney for Applicant
Reg. No.: 44,241
4701 Hedgemore Drive, Suite 250
Charlotte, NC 28209
Tel.: 704-527-4216
Fax.: 704-527-4219